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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,672	03/09/2001	Hiroki Sugiyama	1035-310	4119

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EXAMINER	
VU, KIEU D	

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/801,672	SUGIYAMA ET AL.	
	Examiner	Art Unit	
	Kieu D. Vu	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-7,9-22,24-30 and 32-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2-7,9-22 and 24-30* is/are allowed.

6)☒ Claim(s) *32-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/25/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is responsive to the Amendment filed 04/25/05.

2. Claims 2-7, 9-22, 24-30, and 32-38 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 32 is rejected under 35 U.S.C. 101 because the claimed "A computer data signal embodied in a carrier wave or other digital data communications medium" is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and are therefore non-statutory. See State Street, 149 F.3d at 1374-75, 47 USPQ2d at 1602 (Fed. Cir. 1998) (MPEP 2106)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 33-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al ("Brown", USP 6356908), Carpenter et al ("Carpenter", USP 5754174), and Shisler et al ("Shisler", USP 6801926).

Regarding claims 33-34 and 36, Brown teaches an image information processing steps, comprising a display (fig. 2); an image information storage (col 6, lines 23-27); a

display controller for causing the display means to display sets of detailed information (the left area of window in Fig. 14) and identifier images (thumbnails in the right area of window in Fig. 14) (Fig. 14 and col 8, lines 60-64). Brown teaches that the detailed information includes a plurality of items about this information (URL address, page size, language). Brown does not teach the change in the display order of the detail information and the identifier images. However, such feature is known in the art as taught by Carpenter. Carpenter teaches a system for individually configurable panel interfaces which comprises the change in order of the displays of panel interfaces when the corresponding listing in the configuration menu changes (col 2, lines 4-10; Figures 9-10). Carpenter further teaches the rearranging the display order of the sets of detailed information on the display screen of the display means (Figures 9-10). It would have been obvious to one of ordinary skill in the art, having the teaching of Brown and Carpenter before him at the time the invention was made, to modify the image information processing device taught by Brown to include the change in display order taught by Carpenter with the motivation being to present information and images in different display orders. Brown and Carpenter do not teach rearranging information is automatically performed in response to a manipulation of a displayed item selection button. However, such feature is known in the art as taught by Shisler. Shisler teaches a data processing system having user interface screens for selecting and sequencing selection sort objects (col 18, lines 40-42). Shisler further teaches rearranging information is automatically performed in response to a manipulation of a displayed item selection button (col 18, lines 40-54, see displayed "Properties" button in Fig. 21, see

descriptive text "Properties" on the "Properties" button). It would have been obvious to one of ordinary skill in the art, having the teaching of Brown, Carpenter, and Shisler before him at the time the invention was made, to apply Shisler's teaching in the system taught by Brown and Carpenter with the motivation being to provide a quick and convenient way in rearranging information.

Regarding claim 37, Shisler further teaches the rearranging information in ascending or descending sort order according to image information size (col 18, lines 40-54).

7. Claims 35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Carpenter, and Hodson et al ("Hodson", USP 5710604).

Regarding claim 35, Brown teaches an image information processing device, comprising a display (fig. 2); an image information storage (col 6, lines 23-27); a display controller for causing the display means to display sets of detailed information (the left area of window in Fig. 14) and identifier images (thumbnails in the right area of window in Fig. 14) (Fig. 14 and col 8, lines 60-64). Brown teaches the displaying images in different colors (col 2, lines 60-63). Brown does not teach the change in the display order of the detail information and the identifier images. However, such feature is known in the art as taught by Carpenter. Carpenter teaches a system for individually configurable panel interfaces which comprises the change in order of the displays of panel interfaces when the corresponding listing in the configuration menu changes (col 2, lines 4-10; Figures 9-10). It would have been obvious to one of ordinary skill in the art, having the teaching of Brown and Carpenter before him at the time the invention

was made, to modify the image information processing device taught by Brown to include the change in display order taught by Carpenter with the motivation being to present information and images in different display orders. Brown does not teach each different color corresponds to a particular image information storage region. However, such feature is known in the art as taught by Hodson. Hodson teaches a video memory device wherein each different color corresponds to a particular image information storage region (line 63 of col 2 to line 8 of col 3). It would have been obvious to one of ordinary skill in the art, having the teaching of Brown, Carpenter, and Hodson before him at the time the invention was made, to modify the image information processing device taught by Brown and Carpenter to include the Hodson's teaching with the motivation being to increase the efficiency and speed of a video memory for displays (Hodson, col 2,lines 47-49).

Regarding claim 38, Hodson teaches each different color corresponds to a particular image information storage region (line 63 of col 2 to line 8 of col 3) which means that the storage region where the image information is originally stored can be identified by the color.

Allowable Subject Matter

8. Claims 2-7, 9-22, 24-30 are allowed.

Claim 32 contains allowable limitation and would be allowable if rewritten to overcome the 101 rejection set forth above.

See Office Action mailed 04/07/04 for reason for allowance.

9. Applicant's arguments filed on 04/25/05 have been fully considered but they are not persuasive.

Regarding claim 32, see the non-statutory rejection in section 3 above.

In response to Applicant's argument "In contrast to Shisler et al, applicants' specification discloses.....whereby item selection takes place immediately...and does not require the user to make further selections...", it is noted that this limitation is not claimed.

In response to Applicant's argument "Shisler does not teach or suggest... "size" or "image type" ", it is noted that this specific limitation is not claimed.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's argument "although Shisler et al. allows the user to select an ascending or descending sort order by using the further displayed "sort properties" menu 2101, this selection apparently affects only the object currently selected in the list of objects and does not affect the current display of that object in the list of objects" attacks Shisler reference individually. Since Carpenter and Brown teaches rearranging order affects or changes the current display, but does not teach rearranging is performed via manipulation of a button, Shisler selection button is cited in the rejection.

Similarly, Applicant's argument "The Hodson et al. '604 patent is directed toward a video memory device and does not teach or suggest a "display controller for causing the display to display sets of detailed information and identifier images" as set forth in

applicants' claims" attacks Hodson reference individually since Brown teaches this limitation as Brown discloses a display controller for causing the display means to display sets of detailed information (the left area of window in Fig. 14) and identifier images (thumbnails in the right area of window in Fig. 14) (Fig. 14 and col 8, lines 60-64).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art, having the teaching of Brown, Carpenter, and Hodson before him at the time the invention was made, to modify the image information processing device taught by Brown and Carpenter to include the Hodson's teaching with the motivation being to increase the efficiency and speed of a video memory for displays (Hodson, col 2,lines 47-49).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu D. Vu.

The examiner can normally be reached on Mon - Thu from 7:00AM to 3:00PM at 571-272-4057.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached at 571-272-4048.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

571-273-8300

and / or:

571-273-4057 (use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper / amendment be faxed directly to them on occasions).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kieu D. Vu

Patent Examiner

JOHN CABECA
SUPERVISORY PATENT EXAMINE
TECHNOLOGY CENTER 2100